

REMARKS

The Examiner has rejected Claims 1, 3-11, 14, 16-19, 21-22, 25-26 and 28 under 35 U.S.C. §102(e) as being anticipated by Bandera et al. (US 6,332,127). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove. In particular, applicant has amended each of the independent claims to include the subject matter of Claim 13 et al. (or substantially similar language).

The Examiner has rejected Claims 13 and 24 under 35 U.S.C. 103(a) as being unpatentable over Bandera, in view of Dodrill et al. (US 6,738,803). Applicant respectfully disagrees with such rejection.

Specifically, the Examiner relies on the following excerpt from Dodrill to make a prior art showing of applicant's claimed "wherein sending the associated advertisement comprises sending a visual warning when an audio channel of the handheld computer is turned off."

"In particular, the proxy browser 62 stores for each corresponding user device capabilities data that specifies functions that the user device is able to perform. For example, the capabilities data will specify for each user device whether the user device includes a display for alphanumeric or graphical images, whether the user device includes a sound processor for playing digital audio files via a speaker and recording digital audio files using a microphone, whether the user device has a microphone and speaker for reception and playback of analog audio signals, or whether the user device has a numeric keypad (digital or DTMF) or any key for accepting user inputs."

"Hence, the IP network interface card 138 and the PSTN network interface card 144 each are able to perform basic telephony type functions, such as detect an on hook or off-hook condition by the corresponding user device (e.g., IP phone 120 or analog telephone 18c), detect an incoming phone call or message under the control of the voice resource control 132 and notify the corresponding user device accordingly (e.g., by ringing the device or flashing an alert message, etc.), and send and receive audio signals between the user device and the voice resource controller 132." (col. 10, lines 23-35; and col. 11, lines 22-32)

Dodrill, however, merely tracks user capabilities and notifies the user of various conditions. To simply deem applicant's claimed feature met by such general disclosure would require the Examiner to not consider the full weight of applicant's claim limitations.

Most importantly, such excerpts and the remaining Dodrill reference fail to disclose, teach or even suggest "wherein sending the associated advertisement comprises sending a visual warning when an audio channel of the handheld computer is turned off." Only applicant teaches and claims such a visual warning that is sent in association with an advertisement under the specific condition when an audio channel of the handheld computer is turned off.

Further, it appears that the Examiner is relying on the following excerpts from Bandera to make a prior art showing of applicant's claimed "sending the requested content to the handheld computer for display on the screen of the computer" and "sending the associated advertisement to the handheld computer for playing over an audio output device of the handheld computer" (see this or similar language in each of the independent claims).

"Accordingly, as will be described below, an advertising object can be selected for display within a requested Web page based on a user location and/or on the time of day. Exemplary advertising objects may include text files, audio files, video files, image files, and the like."

"The Web server generates the requested Web page with the selected advertising object(s) included therewithin (Block 106). The generated Web page is then served to the mobile Web client (Block 108)." (col. 5, lines 22-26; and col. 7, lines 28-31)

Despite the already-present deficiencies pointed out above and in the spirit of expediting the prosecution of the present application, applicant has further amended the claims to further distinguish the Examiner's proposed combination:

"wherein the audible advertisement is played simultaneously with the display of the requested content on the handheld computer, free of a visual

advertisement for preserving space available on the screen for the purpose of solely displaying the requested content" (see all independent claims).

Thus, it is now even clearer in the claims that applicant provides a technique of advertising on handheld computers that preserves space available on the screen for the purpose of solely displaying the requested content by excluding any visual advertisements. Further, by providing such novel technique, a particular synergistic benefit is incurred by applicant's novel claimed "sending the associated advertisement comprises sending a visual warning when an audio channel of the handheld computer is turned off."

Specifically, simply nowhere in the prior art is there such a unique handheld computer advertisement technique, as claimed, in synergistic combination with the visual notice, as claimed, to ensure that the audible advertisement is received by the handheld computer user. This is of particular importance, since there is no visual advertisement, and the visual warning serves to prompt a user to turn the audio channel on, so that the audible advertisement is received.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all the claim limitations.

Still yet, applicant brings the Examiner's attention to the following additional claims which include novel subject matter:

"wherein upon the audio channel being opened, a notice is sent to an advertisement server so that the advertisement server can again send the audible advertisement" (see Claim 29); and

"wherein the handheld computer connects to the network, the user requests the content by entering a URL into a browser, and the browser generates an HTTP request, wherein, if the audible advertisement is sent in-band with a Web page, the audible advertisement is delivered along with the Web page, and if the advertisement is sent out-of-band with the Web page, the Web page is sent to the browser of the handheld computer and an URL address of an advertisement server is sent to the browser which in turn requests the audible advertisement from the advertisement server, wherein, if the audio channel is turned on at the handheld computer and the advertisement server is configured to send audio advertisements, an audio banner is sent to the handheld computer, and if the audio channel is not turned on, the advertisement server sends a text advertisement to the handheld computer and a request that the audio channel be turned on, and if the handheld computer is configured to convert the text advertisement to audio, the advertisement server sends a text advertisement to the handheld computer which converts the text advertisement into an audio banner" (see Claim 30).

A notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claim limitations, is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. If any fees

are due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. NAI1P309/00.131.02).

Respectfully submitted,

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